REMARKS

In light of the remarks to follow, reconsideration and allowance of this application are respectfully solicited.

In the Office Action under reply, the Examiner required a new title. The title of this application has been amended as suggested by the Examiner.

Claims 1-8 were rejected under 35 USC 103 as being obvious in view of the combination of Inoue (U.S. Patent 5,016,089), Iwasaki (U.S. Patent 6,145,023), Hafner (U.S. Patent 5,925,928) and Robinson (U.S. Patent 5,388,248). Claim 9 was rejected as being obvious in view of the combination of Inoue, Robinson, Hafner and Kokubu (U.S. Patent 5,710,421).

Claims 10, 11 and 13-16 were rejected as being obvious in view of the combination of Inoue, Robinson and Hafner. Claim 17 was rejected as being obvious in view of this combination, taken further with Kokubu.

It is submitted that these claims, as originally presented, are patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 USC 112. Changes to these claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 USC sections 101, 102, 103 or 112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

Claims 1-11, 13-17 and 41-56 are presented for consideration.

As presented, independent claims 1 and 41 (which recite similar limitations) are patentably distinct over the combination of prior art that has been cited against claim 1. Since claims 2-9 depend either directly or indirectly from claim 1 and thus include all of the elements recited by claim 1, it follows that these dependent claims are unobvious over the applied prior art

for the same reasons. Likewise, since claims 42-49 depend either directly or indirectly from claim 41 and thus include all of the elements recited by claim 41, it follows that these dependent claims are unobvious over the applied prior art for the same reasons as explained below with respect to claim 41.

As presented, independent claims 10 and 50 (which recite similar limitations) are patentably distinct over the combination of prior art that has been cited against claim 10. Since claims 11 and 13-17 depend either directly or indirectly from claim 10 and thus include all of the elements recited by claim 10, it follows that these dependent claims are unobvious over the applied prior art for the same reasons. Likewise, since claims 51-56 depend either directly or indirectly from claim 50 and thus include all of the elements recited by claim 50, it follows that these dependent claims are unobvious over the applied prior art for the same reasons as explained below with respect to claim 50.

Claims 1 and 41

Claims 1 and 41 recite, inter alia, "an ***electric switch*** located on said first substantially rectangular surface ... ;" "a control circuit disposed within said card body... for supplying to said terminals a status signal representing the state of said switch;" and "said switch being disposed proximate said terminals and electrically connected to said control circuit." None of Inoue, Iwasaki, Robinson, Hafner and Kokubu, taken alone or in combination, is suggestive of all of the foregoing claim recitations. As the Examiner correctly found, Inoue does not suggest a switch on "said first substantially rectangular surface" that is "proximate said terminals and electrically connected to said control circuit." Furthermore, there is no suggestion that a representation of the state of the switch mechanism 5 of Inoue is "suppl[ied] to said terminals [as] a status signal." The Examiner attempts to cure this deficiency of Inoue by referring to tab 5

of Iwasaki and by characterizing this tab as a "switch." But tab 5 is simply a mechanical slider provided on the housing of a floppy disk; and a floppy disk clearly is not a "memory card" of the type called for in Applicants' claims. As stated in Iwasaki, "tab 5 comprises a slider 5a and an opening window 5b which is closed and opened in accordance the movement of the slider 5a" (col. 1, lines 39-42). This is not an electric switch. Indeed, Iwasaki points out that a separate electric switch is used to detect the open or closed condition of the window (col. 1, lines 44-48). If tab 5 is to be interpreted as a switch, there would be no need for the separate electric switch that Iwasaki requires. Hence, tab 5 is not a switch. Accordingly, if Iwasaki is to be combined with Inoue, as proposed by the Examiner, the resultant structure would replace Inoue's slider 5 with Iwasaki's slider 5a, and would further require an additional contact switch to sense the condition of the slider. It is respectfully submitted that this complicated structure that would result from combining Inoue and Iwasaki in the manner proposed by the Examiner is not "an electric switch located on said first substantially rectangular surface" "disposed proximate said terminals and electrically connected to said control circuit" such that the control circuit "suppl[ies] to said terminals a status signal representing the state of said switch" as recited in claims 1 and 41. At best, the combination proposed by the Examiner supplies a status signal representing the operation of the contact switch which detects the status of slider 5a of Iwasaki.

Still further, if Inoue is modified by Iwasaki, it appears that Iwasaki's tab 5 would be located at or near the rear of Inoue's IC card, such as shown in Fig. 5 of Inoue. This is far from Inoue's connector portion terminals and cannot be considered "proximate said terminals" as recited in claims 1 and 41. An advantageous feature of Applicants' invention is the small size of the memory card, which requires the switch to be "proximate said terminals." The relatively large size of Iwasaki's floppy disk teaches away from the feature of locating Iwasaki's tab 5

"proximate said terminals." It is without question that Iwasaki has no terminals; hence, there is no suggestion to locate tab 5 "proximate" such non-existent terminals.

The additional teachings of Hafner, Robinson and Kokubu do not suggest that an electric switch should be located on the first rectangular surface and proximate the terminals. Hafner and Kokubu do not show a switch; and Robinson provides a write protect switch WPS at the same location as Inoue's slider 5.

Therefore, since significant elements of independent claims 1 and 41 find no correspondence or suggestion in the cumulative teachings of Inoue, Iwasaki, Hafner, Robinson and Kokubu, it follows that these claims are unobvious over the cited prior art. Furthermore, since claims 2-9 depend from claim 1; and since claims 42-49 depend from claim 41, it follows that these dependent claims are unobvious over the cited prior art for the same reasons that have been explained in connection with claims 1 and 41. It is respectfully requested that the rejection of claims 1-9 be withdrawn and that these claims, together with claims 41-49, be found in condition for allowance.

Claims 10 and 50

Claims 10 and 50 recite, inter alia, "an electric switch"; "a control circuit disposed within said card body ... ***responsive to a read status instruction signal from said external device*** to supply said status signal [representing the state of the switch] to said terminals"; "said switch being electrically connected to said control circuit." None of Inoue, Robinson, Hafner and Kokubu, taken alone or in combination, is suggestive of all of the foregoing claim recitations. That Inoue is not suggestive of an ***electric switch*** has been discussed above. There is no teaching in Inoue that a status signal representing the state of Inoue's slider 5 is supplied by a ***control circuit*** to connector portion 4.

While Robinson describes control logic that controls the overall operation of his flash memory card, including the sending out to a host computer status information regarding the memory card (col. 11, lines 27-29 and col. 12, lines 31-39), no description has been found in Robinson that states that this control logic is responsive to a read status instruction signal received from the host to supply the switch status to pin 33 of Fig.3. The Examiner states, "it is understood that the control circuit [of Robinson] receives a read status instruction signal through connector 112... when in communication with a computer" (page 9, first paragraph of the Office Action). However, it is disputed that this, in fact, is "understood." As just mentioned, Robinson fails to provide a teaching from which it will be "understood" that the switch status is supplied in response to a read status instruction signal received from the host. This deficiency of Robinson is not cured by Inoue, Hafner or Kokubu.

Therefore, since significant elements of independent claims 10 and 50 find no correspondence or suggestion in the cumulative teachings of Inoue, Hafner, Robinson and Kokubu, it follows that these claims are unobvious over the cited prior art. Furthermore, since claims 11 and 13-17 depend from claim 10; and since claims 51-56 depend from claim 50, it follows that these dependent claims are unobvious over the cited prior art for the same reasons that have been explained in connection with claims 10 and 50. It is respectfully requested that the rejection of claims 10, 11 and 13-17 be withdrawn and that these claims, together with claims 50-56, be found in condition for allowance.

Double Patenting Rejection

Claims 1-11 and 13-17 were rejected on the ground of obviousness-type double patenting in view of claims 1-13 of U.S. Patent 6,109,939. The present application is a continuation-in-part of the '939 patent. Moreover, the claims of the present application all recite the presence of

an electric switch that is electrically connected to the control circuit. There is nothing in claims 1-13 of the '939 patent that is suggestive of such a switch. As is known, when considering the question of double patenting, it is the claims of the patent and not its specification and description that is compared to the claims of the pending application. In the present case, the claims of the '939 patent do not suggest the use of a switch, much less a switch "disposed proximate said terminals and electrically connected to said control circuit" as recited in Applicants' claims 1-9. Nor is there any suggestion to reconstruct the device of the '939 patent to add a switch.

Claims 10, 11 and 13-17 also recite an electric switch; and further recite a control circuit "responsive to a read status instruction signal from said external device to supply said status signal [representing the state of the switch] to said terminals." The claims of the '939 patent do not recite a switch (as noted above) and do not recite a control circuit, much less a control circuit that responds to a received read status instruction signal. It is unobvious, when considering the claims of the '939 patent, to modify the claimed structure recited in '939 to include a switch and a control circuit of the type called for by claims 10, 11 and 13-17 of the present application.

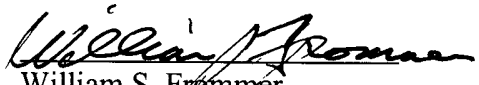
Therefore, since the claims of the present application are not obvious from the **claims** of the '939 patent; and since a device that falls within the scope of the '939 patent claims will not necessarily fall within the scope of the claims of this application (and vice versa), it follows that the claims of this application are unobvious over the **claims** of '939. It is respectfully requested that the rejection based upon obviousness-type double patenting be withdrawn.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of the undersigned attorney and, in the event the Examiner disagrees with

any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the references providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: 
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